



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,918	11/18/2003	Yoshinobu Honkura	245460US0	4019

22850 7590 08/09/2007
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
----------	--------------

1742

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

08/09/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/714,918	Applicant(s) HONKURA ET AL.	
	Examiner John P. Sheehan	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/9/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 9, 2007 has been entered.

Election/Restrictions

2. This application contains claims 14-16 drawn to an invention nonelected with traverse in the paper submitted September 18, 2006.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification-Ex parte Quayle

4. This application is in condition for allowance except for the following formal matter:

Art Unit: 1742

5. The amendment filed December 18, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

I. In Chart 3A, the amendment to the average grain diameter for Sample D1 does not have support in the application as filed. Applicants have cited paragraphs [0133], [0177] and [0178] of the specification as support for this and other amendments. However, none of these cited paragraphs provide support for Sample D1 having an average grain diameter of 35 μm .

Applicant is required to cancel the new matter in the reply to this Office Action..

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Allowable Subject Matter

6. Claims 1 to 12 are allowed.

Art Unit: 1742

7. The rejection of claims 1 to 12 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 to 15 of copending Application No. 10/509,687 has been overcome by the abandonment of 10/509,687.

8. The rejection of claims 1 to 12 under 35 U.S.C. 103(a) as being unpatentable over Kanekiyo et al. (Kanekiyo, US Patent No. 6,814,776) taken in view of Kaneko et al. (Kaneko Japanese Patent No. 2000-003809) has been overcome by the combination of applicants' arguments and the fact that Kanekiyo is directed to an isotropic bonded magnet while the instant claims are directed to an anisotropic magnet. Further, the data set forth in Charts 1A, 1B, 2A, 2B, 3A, 3B, 4 and 5 which show that the combination of claim limitations results in a magnet having improved properties.

9. The rejection of claims 1 to 12 under 35 U.S.C. 103(a) as being unpatentable over Satou et al. (Satou, Japanese Patent Document No. 06-132107, cited in the IDS submitted November 18, 2003) taken in view of the combination of Kaneko et al. (Kaneko Japanese Patent No. 2000-003809) and Kanekiyo et al. (Kanekiyo '546, US Patent Application Publication 2003/0019546) has been overcome by the combination of applicants' arguments and the data set forth in Charts 1A, 1B, 2A, 2B, 3A, 3B, 4 and 5 which show that the combination of claim limitations results in a magnet having improved properties.

Response to Amendment

10. Applicant's arguments regarding the objection to the specification, filed July 9, 2007 have been fully considered but they are not persuasive.

Art Unit: 1742

11. Regarding the objection to the amendment filed December 18, 2006 as introducing new matter into Chart 3A, by changing the average grain diameter of Sample D1 from 45 μm to 35 μm , applicants argue that the error would have been obvious. The Examiner agrees that 45 μm is an error in view of the description regarding Sample D1 in Chart 3B under the heading "Point of Comparison" which states that the NdFeB powder has an average grain size below the lower limit recited in the claims that is below 45 μm . Applicants then argue that correct grain size would have been obvious in that the skilled artisan could reproduce the experiments at 45 μm and 35 μm to see from which average grain size the remaining results are obtained. The Examiner does not agree. First, having to do experimental work to determine the correct grain size for Example D1 is not what one would consider as making the correct grain size obvious. Further, in doing this experimental work why would it be obvious to the skill artisan to use 35 μm and not 38 μm or any other grain size less than 45 μm ? Applicants then argue that the correction does not affect the claims and therefore should be allowed entry. The Examiner is not persuaded. Introducing subject matter that does not have support into an application is new matter whether or not the subject matter affects the claims.

Conclusion

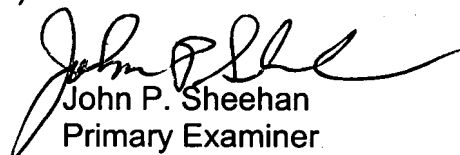
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571)

Art Unit: 1742

272-1249. The examiner can normally be reached on T-F (6:45-4:30) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John P. Sheehan
Primary Examiner
Art Unit 1742

jps